



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------|-------------|----------------------|---------------------|------------------|
| 10/646,376 | 08/21/2003 | Volker Stade | 11349-18-999 | 8582 |
| 20583 | 7590 | 04/14/2005 | EXAMINER | |
| JONES DAY | | | HAWKINS, CHERYL N | |
| 222 EAST 41ST ST | | | ART UNIT | |
| NEW YORK, NY 10017 | | | PAPER NUMBER | |

1734

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,376

Applicant(s)

STADE, VOLKER

Examiner

Cheryl N. Hawkins

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 2/7/05; 3/31/05.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. Applicant is advised that should claim 9 be found allowable, claim 10 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation "the cross-sectional dimension" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "the cross-sectional dimension" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 1734

5. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites a hand-held device comprising "at least one guiding web" in line 2 of the claim and then goes on to recite "said guiding web" in line 3 of the claim. For the purposes of examination, it will be assumed that "said guiding web" in line 3 should read --said at least one guiding web--.

6. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 recites the limitation "the cross-sectional dimension" in lines 13-14 of the claim. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 24-26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 recites a hand-held device comprising a "guiding web" in line 14 of the claim and then goes on to recite "said at least one guiding web" in line 16 of the claim. For the purposes of examination, it will be assumed that "guiding web" in line 14 should read --at least one guiding web--.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 5-12, and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi (JP 11-157290). Kobayashi discloses a hand-held device (Figure 1, transfer utensil 1) for transferring a film (Figure 4, film 26) from a backing tape (Figure 4, carrier tape 25) onto a substrate (Figure 1, substrate 28), the device comprising a housing (Figure 1, case 2) in which a supply of the backing tape is arranged (Figure 1, supply reel 3); and an application member (Figure 1, transfer head 5) projecting from the housing and having a front end with a free end and at least a first application edge (Figure 12c, pressing part 35) and a second application edge (Figure 12a, pressing part 16), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side; and a third application edge (Figure 12a, pressing part 15) projecting from the lower longitudinal side of the application member between the first application edge and the second application edge; wherein the second application edge projects from the lower longitudinal side of the application member.

As to Claim 2, Kobayashi discloses a hand-held device wherein the first and second application edges (Figure 12a and 12c, pressing parts 35 and 16) have mid-central planes enclosing an angle of approximately 30° to 120°.

As to Claim 3, Kobayashi discloses a hand-held device wherein the mid-central planes of the first and second application edges (Figure 12a and 12c, pressing parts 35 and 16) enclose an angle of approximately 45° to 90° .

As to Claim 5, Kobayashi discloses a hand-held device wherein the height of the second application edge (Figure 12, pressing part 16) is greater than the cross-sectional dimension of the first application edge (Figure 12, pressing part 35).

As to Claim 6, Kobayashi discloses a hand-held device wherein the application member has a shaft (Figure 2, plate-like member 17); and the height of the third application edge (Figure 2, pressing part 15) is greater than the cross-sectional dimension of the shaft of the application member.

As to Claim 7, Kobayashi discloses a hand-held device wherein the cross-sectional shape of the second application edge (Figure 12a, pressing part 16) and the third application edge (Figure 12a, pressing part 15) is convergent.

As to Claim 8, Kobayashi discloses a hand-held device wherein the cross-sectional shape of the third application edge (Figure 12a, pressing part 15) is wedge-shaped.

As to Claims 9 and 10, Kobayashi discloses a hand-held device wherein the housing has a lower border and a bottom side; and the second application edge extends beyond at least one of the adjacent lower border of the housing or the bottom side of the housing (see Figure 1).

As to Claim 11, Kobayashi discloses a hand-held device wherein the application member has a front end portion movable upwards against an elastic restoring force (Figure 1, engagement section 10).

As to Claim 12, Kobayashi discloses a hand-held device wherein the application member has a rear end portion fixedly held in the housing (Figure 1, engagement section 10); and the

Art Unit: 1734

application member is elastically flexible in a vertical direction in at least a partial area of its length (see paragraph 18 of the machine translation of JP 11-157290).

As to Claim 14, Kobayashi disclose a hand-held device which includes at least one guiding web (Figure 2, guides 18) projecting backwards from a backside of the application edge on at least one side, the guiding webs having an inner side guiding the backing tape being wound around the second application edge.

As to Claim 15, Kobayashi discloses a hand-held device wherein the second application edge (Figure 12a, pressing part 16) is offset backwards in relation to the first application edge (Figure 12c, pressing part 35) in a direction closer to the housing.

As to Claim 16, Kobayashi discloses a hand-held device wherein the first application edge (Figure 2, pressing part 15) is the front end of a longitudinally extending shaft (Figure 2, plate-form member 17) of the application member.

As to Claim 17, Kobayashi discloses a hand-held device wherein the application member is formed with a necking (see Figure 1, transfer head 5).

As to Claim 18, Kobayashi discloses a hand-held device wherein the application member has a rear end closer to the housing than the front end; and the necking is formed at the rear end of the application member (see Figure 1, transfer head 5).

10. Claims 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Manusch et al. (US 6,105,650). As to Claim 19, Manusch et al. discloses a hand-held device for transferring a film (Figure 1, tape 7) from a backing tape (Figure 1, carrier tape 6) onto a substrate (Figure 1, substrate 8), the device comprising a housing in which a supply of the backing tape is arranged (column 5, lines 36-39); and an application member (Figure 1, applicator foot 3) projecting from

Art Unit: 1734

the housing and having a shaft and at least a free end, a first application edge (Figures 1-3, application toe 4a) and a second application edge (Figures 1-3, application toe 4b), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side; wherein the second application edge (Figure 2, application toe 4b) projects from the lower longitudinal side of the application member; the second application edge has a height greater than a cross-sectional dimension of the first application edge; and the second application edge has a wedge-shaped cross-sectional shape.

As to Claim 20, Manusch et al. discloses a hand-held device for transferring a film (Figure 1, tape 7) from a backing tape (Figure 1, carrier tape 6) onto a substrate (Figure 1, substrate 8), the device comprising a housing in which a supply of the backing tape is arranged (column 5, lines 36-39); and an application member (Figure 1, applicator foot 3) projecting from the housing and having a front end with a free end and at least a first application edge (Figures 1-3, application toe 4a) and a second application edge (Figures 1-3, application toe 4b), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side opposite the lower longitudinal side; wherein the second application edge projects from the lower longitudinal side of the application member with a mid-central plane transverse to a mid-central plane of the first application edge; and the first and second application edges extend across approximately the entire width of the application member.

As to Claim 21, Manusch et al. discloses a hand-held device wherein the first and second application edges (Figures 1-3, applicator toes 4a and 4b) have mid-central planes enclosing an angle of approximately 90°.

11. Claims 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Manusch et al. (US 4,853,074). Manusch et al. discloses a hand-held device for transferring a film (Figure 3a, film 5a) from a backing tape (Figure 3a, carrier tape 5) onto a substrate (Figure 3a, substrate 17), the device comprising a housing in which a supply of the backing tape is arranged (column 6, lines 40-42); an application member (Figure 1, applicator element 4, applicator bar 14) projecting from the housing and having a front end with a free end and at least a first application edge (Figure 4b, pressure-application edge 14') and a second application edge (Figure 4d, heel edge 18), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side; wherein the second application edge projects from the lower longitudinal side of the application member with a mid-central plane transverse to a mid-central plane of the first application edge; and the first and second application edges extend across approximately the entire width of the application member.

As to Claim 21, Manusch et al. discloses a hand-held device wherein the first and second application edges (Figure 4d, pressure-application edge 14' and heel edge 18) have mid-central planes enclosing an angle of approximately 90°.

As to Claim 22, Manusch et al. discloses a hand-held device wherein the housing (Figures 1 and 2, covers 2a and 2b) has a lower border and a bottom side; and the second application edge (Figure 4d, heel edge 18) extends beyond the lower border of the housing and the bottom side of the housing.

As to Claim 23, Manusch et al. discloses a hand-held device wherein the second application edge (Figure 4d, heel edge 18) is offset backwards in relation to the first application edge (Figure 4d, pressure-application edge 14') in a direction closer to the housing.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-3 and 5-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (JP 11-157290) in view of Morinaga (US 5,772,840) and Manusch et al. (US 5,462,633). As to Claim 1, Kobayashi discloses a hand-held device (Figure 1, transfer utensil 1) for transferring a film (Figure 4, film 26) from a backing tape (Figure 4, carrier tape 25) onto a substrate (Figure 1, substrate 28), the device comprising a housing (Figure 1, case 2) in which a supply of the backing tape is arranged (Figure 1, supply reel 3); and an application member (Figure 1, transfer head 5) projecting from the housing and having a front end with a free end and at least a first application edge (Figure 12c, pressing part 35) and a second application edge (Figure 12a, pressing part 16), the backing tape being wound around the free end and the

Art Unit: 1734

application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side; and a third application edge (Figure 12a, pressing part 15) projecting from the lower longitudinal side of the application member between the first application edge and the second application edge; wherein the second application edge projects from the lower longitudinal side of the application member.

As to Claim 2, Kobayashi discloses a hand-held device wherein the first and second application edges (Figure 12a and 12c, pressing parts 35 and 16) have mid-central planes enclosing an angle of approximately 30° to 120° .

As to Claim 3, Kobayashi discloses a hand-held device wherein the mid-central planes of the first and second application edges (Figure 12a and 12c, pressing parts 35 and 16) enclose an angle of approximately 45° to 90° .

As to Claim 5, Kobayashi discloses a hand-held device wherein the height of the second application edge (Figure 12, pressing part 16) is greater than the cross-sectional dimension of the first application edge (Figure 12, pressing part 35).

As to Claim 6, Kobayashi discloses a hand-held device wherein the application member has a shaft (Figure 2, plate-like member 17); and the height of the third application edge (Figure 2, pressing part 15) is greater than the cross-sectional dimension of the shaft of the application member.

As to Claim 7, Kobayashi discloses a hand-held device wherein the cross-sectional shape of the second application edge (Figure 12a, pressing part 16) and the third application edge (Figure 12a, pressing part 15) is convergent.

As to Claim 8, Kobayashi discloses a hand-held device wherein the cross-sectional shape of the third application edge (Figure 12a, pressing part 15) is wedge-shaped.

As to Claims 9 and 10, Kobayashi discloses a hand-held device wherein the housing has a lower border and a bottom side; and the second application edge extends beyond at least one of the adjacent lower border of the housing or the bottom side of the housing (see Figure 1).

As to Claim 11, Kobayashi discloses a hand-held device wherein the application member has a front end portion movable upwards against an elastic restoring force (Figure 1, engagement section 10).

As to Claim 12, Kobayashi discloses a hand-held device wherein the application member has a rear end portion fixedly held in the housing (Figure 1, engagement section 10); and the application member is elastically flexible in a vertical direction in at least a partial area of its length (see paragraph 18 of the machine translation of JP 11-157290).

As to Claim 13, Kobayashi does not disclose a hand-held device wherein the application member is rotatably mounted about a swivel axis extending in the housing. Morinaga discloses a hand-held device wherein the application member is rotatably mounted about a swivel axis extending in the housing such that when the housing is laterally tilted during the application operation the application member can be rotated to ensure that the tape is entirely adhered on the application surface (column 3, lines 4-27). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the application member of Kobayashi to be rotatably mounted about a swivel axis extending in the housing as suggested by Morinaga to ensure complete adherence of the tape on the application surface regardless of the position of the housing during application. Also, Kobayashi does not disclose a hand-held device wherein the application member is mounted upwards against an elastic restoring force. Manusch et al. discloses a hand-

Art Unit: 1734

held device wherein the application member is mounted upwards against an elastic force to ensure good adherence of the film while avoiding deformation of the film (column 3, lines 18-26). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the application member of Kobayashi to be mounted upwards against an elastic force as suggested by Manusch et al. to ensure good adherence of the film while avoiding deformation of the film during the application process.

As to Claim 14, Kobayashi disclose a hand-held device which includes at least one guiding web (Figure 2, guides 18) projecting backwards from a backside of the application edge on at least one side, the guiding webs having an inner side guiding the backing tape being wound around the second application edge.

As to Claim 15, Kobayashi discloses a hand-held device wherein the second application edge (Figure 12a, pressing part 16) is offset backwards in relation to the first application edge (Figure 12c, pressing part 35) in a direction closer to the housing.

As to Claim 16, Kobayashi discloses a hand-held device wherein the first application edge (Figure 2, pressing part 15) is the front end of a longitudinally extending shaft (Figure 2, plate-form member 17) of the application member.

As to Claim 17, Kobayashi discloses a hand-held device wherein the application member is formed with a necking (see Figure 1, transfer head 5).

As to Claim 18, Kobayashi discloses a hand-held device wherein the application member has a rear end closer to the housing than the front end; and the necking is formed at the rear end of the application member (see Figure 1, transfer head 5).

Art Unit: 1734

14. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch et al. (US 4,853,074) in view of Kobayashi (JP11-157290). Manusch et al. discloses a hand-held device for transferring a film (Figure 3a, film 5a) from a backing tape (Figure 3a, carrier tape 5) onto a substrate (Figure 3a, substrate 17), the device comprising a housing in which a supply of the backing tape is arranged (column 6, lines 40-42); an application member (Figure 1, applicator element 4, applicator bar 14) projecting from the housing and having a front end with a free end and at least a first application edge (Figure 4b, pressure-application edge 14') and a second application edge (Figure 4d, heel edge 18), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side; wherein the second application edge projects from the lower longitudinal side of the application member and is offset backwards in relation to the first application edge in a direction closer to the housing. Manusch et al. does not disclose a hand-held device which includes a guiding web projecting backwards from a backside of the second application edge facing the housing on at least one side of the second application edge. It is well known and conventional in the tape dispenser art, as disclosed by Kobayashi (Figure 2, guides 18), to provide a hand-held device for transferring a film with guiding webs projecting backwards from a backside of the application edge facing the housing on both sides of the application member such that the guiding webs have an inner side guiding the backing tape being wound around the application edge. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the second application edge of Manusch et al. to include guiding webs as

Art Unit: 1734

suggested by Kobayashi to provide means for guiding the backing tape around the application edge; the use of guiding webs being well established in the art.

As to Claim 25, Manusch et al. does not disclose a hand-held device which includes a guiding web projecting from the upper longitudinal side of the application member on at least one side of the first application edge. It is well known and conventional in the tape dispenser art, as disclosed by Kobayashi (Figure 2, guides 18), to provide a hand-held device for transferring a film with guiding webs projecting from the upper longitudinal side of the application member on at least one side of the application edge. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the first application edge of Manusch et al. to include guiding webs as suggested by Kobayashi to provide means for guiding the backing tape around the application edge; the use of guiding webs being well established in the art.

As to Claim 26, Manusch et al. does not disclose a hand-held device which includes a guiding web at each side of the first and second application edges. It is well known and conventional in the tape dispenser art, as disclosed by Kobayashi (Figure 2, guides 18), to provide a hand-held device for transferring a film with guiding webs at each side of the application edge and having a distance therebetween which conforms to the width of the backing tape to form guiding surfaces for the backing tape. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the first and second application edges of Manusch et al. to include guiding webs as suggested by Kobayashi to provide means for guiding the backing tape around the application edge; the use of guiding webs being well established in the art.

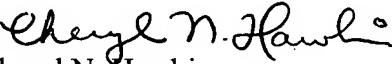
Art Unit: 1734


Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl N. Hawkins whose telephone number is (571) 272-1229. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (517) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cheryl N. Hawkins
April 7, 2005


CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER
Art 1734